

*A conc'd.*

perfluoroalkyl silazanes, polyhexafluoropropylene oxides, perfluoroalkyl-group-containing organosiloxanes, per-fluoropolyethers, perfluoro alcohols, perfluoroalkylacrylate polymers, and derivatives thereof.

### REMARKS

#### I. Status of the Claims

Claims 1-41 are pending in this application. Claim 7 has been amended to correct an obvious typographical error. Applicants acknowledge and appreciate that the rejections under 35 U.S.C. §§ 102 and 112, second paragraph, have been withdrawn.

#### II. Rejection Under 35 U.S.C. § 103

The Examiner has maintained the rejection of claims 1-41 under 35 U.S.C. § 103(a) as unpatentable over Japanese Application No. JP 11 - 021227 to *Takeshi* ("Takeshi") and U.S. Patent No. 5,567,420 to *McEleney et al.* ("McEleney"). The Examiner alleges that "[a]lthough the prior art is silent on treating the surface of the pigments and fillers, in the absence of unexpected results, one of ordinary skill in the art would expect the untreated surface of a pigment or filler to provide similar results as the treated surface." (Office Action dated December 21, 2001, page 3, lines 14-16.) Applicants respectfully disagree and traverse this rejection for at least the reasons of record and the additional reasons detailed below.

To establish a *prima facie* case of obviousness, the Examiner bears the burden of establishing at least that the prior art references teach or suggest all of the elements of the claimed invention. M.P.E.P. § 2143 (emphasis supplied). In the present case,

the Examiner has not shown that the *Takeshi/McEleney* combination teaches or suggests all of the claimed invention's elements.

Claim 1 of the present invention recites, among other things, "at least one ingredient chosen from pigments and fillers, wherein the at least one ingredient has been surface-treated by at least one water-repellant and oil-repellant agent." The *Takeshi/McEleney* combination does not teach this aspect of Applicants' claims, and the Examiner acknowledges this deficiency by stating that "the prior art is silent on treating the surface of the pigments and fillers." (Office Action dated December 21, 2001, page 3, line 14.) The Examiner must consider, however, the phrase "wherein the at least one ingredient has been surface-treated by at least one water-repellant and oil-repellant agent" as an element of claim 1:

[W]hen evaluating the scope of a claim, every limitation in the claim must be considered. Office personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation. Instead, the claim as a whole must be considered.

M.P.E.P. § 2106(II)(C) (emphasis in original) (citation omitted). This the Examiner has not done, therefore, the obviousness rejection is improper.

Additionally, the Examiner must present a "full and reasoned explanation" of her decision, wherein the reasons supporting the decision are articulated and the decision is sound. *In re Lee*, 277 F.3d 1338, 1342 (Fed. Cir. 2002). Here, the Examiner merely concludes that "one of ordinary skill in the art would expect the untreated surface of a pigment or filler to provide similar results as the treated surface." (Office Action dated December 21, 2001, page 3, lines 15-16.) The Examiner, however, has failed to explain why and how she reached this conclusion. The Examiner further alleges that

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"applicants must provide a showing of unexpected result for surface treated and untreated pigment or filler." (Office Action dated December 21, 2001, page 3, lines 17-18.) This is not Applicants' burden. Unless and until the Examiner factually supports a *prima facie* conclusion of obviousness, Applicants are not obliged to submit evidence of nonobviousness. M.P.E.P. § 2142.

Contrary to what the Examiner suggests, Applicants are not required to show unexpected results because, as is explained above, the Examiner has not established a *prima facie* case of obviousness. Assuming *arguendo* that the Examiner has made a *prima facie* case of obviousness (and Applicants maintain she has not), the as-filed specification provides a comparison of gel compositions comprising surface-treated pigment against gel compositions comprising untreated pigment. (Specification, Table 1, page 11.) The results are summarized here for the convenience of the Examiner:

**Table 1**

Gel Composition	1 inventive composition	2 comparative composition	3 comparative composition	4 comparative composition	5 comparativ composition
Polyacrylamide-based polymer*	+			+	+
Carboxyvinyl polymer		+			
Acrylate-based cross-linked polymer**			+		
Perfluoroalkyl phosphate treated pigment	+	+	+		
Untreated pigment				+	
Silicone-treated pigment					+
Texture/Stability	very good	poor	poor	good	good
Lasting/Sense of application	good	good	good	poor	fair

Table 1 shows that gel composition 1, which falls within the scope of the invention, exhibits very good texture and stability and good properties of lasting and

sense of application. Gel composition 4, for example, only exhibits good texture and stability and poor properties of lasting and sense of application. Thus, contrary to the Examiner's conclusory findings, the surface-treated pigments of the invention provide results different than the untreated pigments.

Accordingly, as the Examiner has neither established a *prima facie* case of obviousness, nor articulated the reasoning supporting the rejection, Applicants respectfully request its withdrawal.

### III. Conclusion

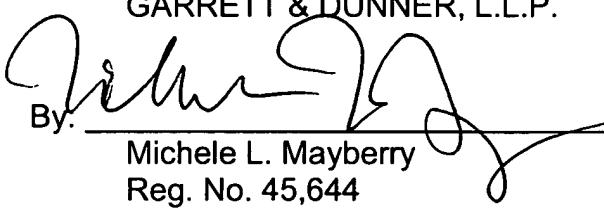
In view of the foregoing remarks, Applicants respectfully request the reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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By:

  
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Dated: March 19, 2001

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Attachment: Appendix (Version With Markings to Show Changes Made)

**Appendix to Amendment of March 19, 2002**

**Version With Markings to Show Changes Mad**

**IN THE CLAIMS:**

Please replace claim 7 with amended claim 7, as follows:

7. (Once Amended) A composition according to claim 6, wherein the fluorine compounds are chosen from ~~perfluororalkyl perfluoroalkyl~~ phosphates, perfluoroalkyl silanes, perfluoroalkyl silazanes, polyhexafluoropropylene oxides, perfluoroalkyl-group-containing organosiloxanes, per-fluoropolyethers, perfluoro alcohols, perfluoroalkylacrylate polymers, and derivatives thereof.

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